



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,002	11/24/2003	Gregory E. Ross	150449C1	3973
38598 7590 04/02/2008 ANDREWS KURTH LLP 1350 I STREET, N.W. SUITE 1100 WASHINGTON, DC 20005			EXAMINER JOLLEY, KIRSTEN	
			ART UNIT 1792	PAPER NUMBER
			MAIL DATE 04/02/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/720,002	<b>Applicant(s)</b> ROSS, GREGORY E.	
	<b>Examiner</b> Kirsten C. Jolley	<b>Art Unit</b> 1792	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on November 5, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of RE 39,044 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Amendments/Arguments***

2. The consent of the assignee in this reissue application filed November 5, 2007 is acknowledged and accepted.
3. The obviousness-type double patenting rejections set forth in the prior Office action have been withdrawn in response to Applicant's filing of a terminal disclaimer.
4. The objection to the specification and the objections to the claims have been withdrawn in response to Applicant's amendments to the specification and claims.
5. The 35 USC 112 (1<sup>st</sup> paragraph) and 251 rejections over claims 32-43 set forth in the prior Office action have been withdrawn in response to Applicant's amendments to the claims, however the 35 USC 112/251 rejections over claims 23-31 set forth in section 9 of the prior Office action have been maintained for the reasons discussed below.
6. The 35 USC 112, 2<sup>nd</sup> paragraph rejections set forth in the prior Office action have been withdrawn in response to Applicant's arguments.
7. With respect to the rejections over the prior art of Hill, Applicant's arguments filed November 5, 2007 have been fully considered but they are not persuasive.

Applicant argues that Hill does not disclose or suggest applying energy to a portion of a first coating through an overcovered region of a second coating to alter a characteristic of the first coating. Applicant also argues that Hill does not disclose or suggest applying such energy during formation of a pattern. The Examiner disagrees. Hill teaches in col. 10, lines 38-49, that a transfer method may be used for applying the coatings where a transfer or decal having ceramic inks are applied to a glass base material, following by heating in a toughening furnace such that the carrying membrane is burnt off and the ceramic ink is fused into the surface of the glass. Hill teaches "more than one of these can be placed side by side to build up the required area." It is the Examiner's position that in building up first and second coating layers and then heating the built-up decal/transfer simultaneously, a characteristic (including the shape) of the first coating over-covered by the second coating is necessarily altered during the fusing process. The fusing/toughening furnace emits heating energy onto the first coating over-covered by the second coating.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 23-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for modifying the first coating by making it opaque or transparent, expand or contract, or have a surface reaction upon exposure to energy, does not reasonably provide enablement for "modifying at least a portion of said first coating ... such that a characteristic of

said first coating is altered”, as claimed in claim 23. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims because the specification does not disclose every possible alteration of the first coating. There is not support in the disclosure commensurate in scope with claims 23-31. While independent claim 23 was amended to clarify that the first coating is modified by applying energy, the claim none-the-less reads on altering *any* characteristic of the first coating and is broader than the specification enables; the specification does not provide support or enable a person skilled in the art to alter the first coating in any possible manner.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 23-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill (US 4,673,609).

Hill is applied for the reasons discussed in the prior Office action, as well as for the reasons discussed above in section 7.

With respect to newly added limitation to the independent claims requiring “applying energy to said portion of said first coating through an over-covered region of said second coating,” Hill discloses using a transfer method for applying the coatings where a transfer or

decal having ceramic inks are applied to a glass base material, following by heating in a toughening furnace such that the carrying membrane is burnt off and the ceramic ink is fused into the surface of the glass (col. 10, lines 38-49). Hill teaches "more than one of these can be placed side by side to build up the required area." It is the Examiner's position that in building up first and second coating layers and then heating the built-up decal/transfer simultaneously, a characteristic of the first coating over-covered by the second coating is necessarily altered during the fusing process. The energy that is applied is heat energy, and the shape of the first coating is altered by this fusing process. Alternatively, in the case of applying each layer of ceramic ink by transfer/decal successively (one layer at a time), a characteristic of the first coating over-covered by the second coating is altered since the temperature of the first coating is elevated during the heating step of fusing the second coating.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Tuesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Kirsten C Jolley  
Primary Examiner  
Art Unit 1792

kcj